

## **REMARKS**

### **Formal Matters**

Claims 33-61 are pending after entry of the amendments set forth herein.

Claims 33-58 were examined. Claims 34, 41-44, 46-50 and 52 are withdrawn from consideration. Claims 33, 35-40, 45, 51, 53-58 were rejected

Claims 33, 35, 39, 40, 47-52 are amended; claims 59-61 are added. Support for these amendments and new claims are found throughout the specification, as well as in the claims as originally filed or previously presented. For example, support for hybridization conditions recited in the claims appears in the specification at, for example, page 11, lines 29-30; page 14, lines 12-25. The amendments are intended to retain coverage for equivalents of the claimed sequences and homologs to which applicants were previously entitled. Applicants further reserve the right to reintroduce claims to cancelled subject matter or anything else described in the specification in this or any other application.

Applicants respectfully request entry of the amendments set out above, and reconsideration of the application in view of the amendments and remarks made herein.

No new matter has been added.

### **Interview Summary**

Applicants extend their gratitude to Examiners Murphy and Eyler for the interview conducted with the undersigned and the licensee's representative Michael Schiff on November 13, 2003. All outstanding rejections of the claims were discussed, as well as the restriction requirement.

The Examiners agreed that claims directed to non-elected sequences would be rejoined with the currently pending claims in view of the fact that the molecules corresponding to these sequences had been deemed patentable in an earlier-filed application (see, e.g., U.S. Pat. No. 6,593,456). Applicants discussed with the Examiners the arguments and amendment presented in the prior response. It was agreed that the arguments previously presented avoided the rejections of all claims except claim 33 and its dependents. The Examiners also agreed that amendment of claim 33 as set forth herein would avoid the rejections of all remaining claims under §112, ¶1, as well as the rejections of the claims under §102(b) and §103(a).

**Election/Restriction**

As noted above, the Examiners agreed during the interview of November 13, 2003 that claims directed to non-elected sequences would be rejoined with the currently pending claims in view of the fact that the polypeptides contained in SEQ. ID NOs:151, 153, and 154, or encoded in SEQ. ID NOs:1, 5, 6, 8, 9, or 10 had been deemed patentable in an earlier-filed application (USSN 09/081,253) to which this application claims priority. The earlier application issued as U.S. Pat. No. 6,593,456 on July 15 of this year.

Since protein related to the sequences recited in the instant claims have already been searched and deemed patentable, there is no undue burden is imposed upon the Office in examination of methods directed to the use of proteins related to the same sequences. Under these circumstances, the invention should not be divided into separate applications (MPEP §803), whether or not the sequences are patentably distinct.

Applicants therefore respectfully request rejoinder of claims 33, 35-40, 45, 51 and 53-58 with the present claims.

**Claim Objections**

Claims 35, 39 and 40 were objected on the grounds these claims contained limitations drawn to non-elected inventions. In view of the Examiners' agreement to withdraw the restriction requirement and rejoin the polypeptides recited in these claims, withdrawal of these objections is respectfully requested.

**Rejection Under §112, ¶1 – Written Description and Enablement**

Claims 35, 39, 40, 45 and 51, and claims 33, 36-38, and 53-58 were rejected on grounds that the specification does not reasonably provide enablement for a method of screening substances for an ability to affect the TRRE activity of the protein encoded by a fragment of the longest open reading frame of SEQ ID NO:9 or a method of screening substances for an ability to affect the TRRE activity of the protein encoded by a polynucleotide that hybridizes to a nucleic acid that encodes SEQ ID NO:9.

Claims 35, 39, 40, 45, and 51, and claims 33-36-38 and 53-58 were rejection on the grounds the specification does not provide an adequate written description for variants.

These rejections are rejection respectfully traversed as applied and as they may be applied to the presently pending claims. In particular, it is applicants' position that claim 35 and its dependents is

patentable *inter alia* because the stated scope of the protein variants comports with Example 9 of the written description guidelines, and can be made by the skilled reader without undue experimentation. Claim 33 as previously presented defined the protein used in screening as having a means to causes TNF receptor to be cleaved in the absence of the substance. This is in accordance with 35 USC § 112 ¶ 6.

During the interview, the arguments presented in the prior response with respect to these rejections were discussed, and these arguments deemed sufficient to withdraw this rejection of the claims as applied to claims 35, 39, 40, 45 and 51. It was further agreed that amendment of claim 33 as set out in this response would be sufficient to avoid the rejection as applied to claim 33 and its dependent claims.

Withdrawal of these rejections under §112, ¶1 is respectfully requested.

**Rejections under §112, ¶2**

Claims 40 and 51 were rejected as being indefinite for recitation of “stringent conditions”. This rejection is rendered moot in view of the amendment to these claims.

Claim 33 was rejected as indefinite for lack of antecedent basis of “the peptide”. This rejection is also rendered moot by amendment.

Withdrawal of the rejections of the claims under §112, ¶2 is respectfully requested.

**Rejections Under §102(b) and §103(a)**

Claims 33, 37-38, 53-56 and 58 were rejected as being anticipated by Katsura et al. (1996).

Claims 33, 37-38, and 53-58 were rejected as being obvious over Katsura et al. (1996) in view of Bjornberg et al. (1995).

These rejections are traversed as applied and as they may be applied to the pending claims.

During the interview, it was agreed that amendment of claim 33 as set forth herein would avoid the rejections of claim 33, and its dependents, based on the cited art. Withdrawal of these rejections is respectfully requested.

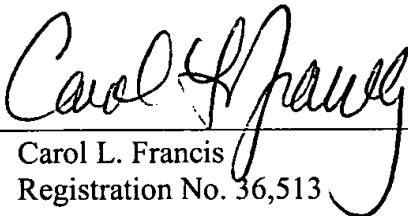
**Conclusion**

Applicant submits that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-0815, order number IRVN-007CON2.

Respectfully submitted,  
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Date: Nov 20, 2003

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